REMARKS

Status of the Claims

Claims 4, 6-9, 11-13, 15-16, 18-19, 22-26, 29-30, 32-34, and 38 are currently amended, and claims 1-3, 5, 10, 14, 17, and 35-37 are canceled, without prejudice or disclaimer. No new matter has been added.

Claims 4, 6-9, 11-13, 15-16, 18-34, and 38-39 are pending, and elected claims 4, 6, 8, 11-13, 15-16, and 18-34, and 38-39 should be examined. Species claims 7 and 9 should be rejoined as a matter of right when the base generic claim 4, from which claims 7 and 9 depend is allowable.

Interview Summary

Applicants thank Examiner George for helpful discussions during the telephone interview of August 31, 2004. The references of record was discussed during the interview. Specifically, Applicants explained that there is no motivation to combine the angiotensin II antagonists of SmithKline Beecham for use in the device of Katz. Moreover, even if there were evidence of such motivation, the resultant combination would not render the presently claimed invention obvious, as Katz teaches "the selection of drug, matrix layer, and chemical penetration enhancer cannot be made independently." See Katz, column 6, lines 3-5. No resolution was reached.

Rejections under 35 U.S.C. § 103

Claims 1-6, 8, and 10-39 remain rejected under 35 U.S.C. § 103 (a) as allegedly unpatentable over SmithKline Beecham Co. (WO 95/06410) in view of Katz et al. (U.S. Patent No. 5,028,435). Applicants respectfully traverse this rejection.

To properly combine references, there must be some teachings or suggestion in the prior art. MPEP § 2142. Thus, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the

desirability of the combination. MPEP § 2143.01. In fact, references cannot be combined when they teach away from their combination. MPEP § 2145X.D.

Furthermore, even if there were a suggestion that implicated such a combination, the combined teachings would not result in the claimed method. To establish a *prima facie* obviousness, all of the claim recitations must be taught or suggested by the prior art. MPEP § 2143.03.

On one hand, the claim 4 recites "wherein the skin permeability regulator comprises a fatty acid ester, a polyol and a nonionic surfactant." See also, claims 34, 37-39, each of which recite different language than claim 4.

According to the PTO, SmithKline Beecham "discloses the use of angiotension II receptor antagonist as a medicament for the treatment of chronic inflammatory diseases." Office Action of June 16, 2003, page 6. Specifically, SmithKline Beecham discloses "the angiotension II receptor antagonist is 1-(cyclohexyloxycarbonyloxy) ethyl-2-ethoxy-1-[(2'-(1H-tetrazol-5-yl) biphenyl-4-yl) methyl]-benzimidazole-7-carboxylate." Id. Yet, as the PTO admits, SmithKline Beecham "does not disclose the skin-contacting base (i.e. adhesive layer) containing the compound and a support." Id. at page 7. Therefore, according to the evidence and explanation of record, SmithKline Beecham does not teach a skin permeability regulator that is a fatty acid ester, a polyol, and a nonionic surfactant. Accordingly, SmithKline Beecham would not render the present invention obvious.

To remedy its deficiencies, the PTO relies on Katz et al. Yet Applicants submit that Katz does not disclose a skin permeability regulator that is a fatty acid ester, a polyol, and a nonionic surfactant. Accordingly, Katz would not remedy SmithKline Beecham's deficiencies. Thus, the cited combination of references does not disclose all elements of the claims and, hence, does not establish a *prima facie* case under Section 103. For at least this reason, the rejection is improper and should be withdrawn.

CONCLUSION

Reconsideration and reexamination of the present claims is requested. If there are any questions concerning this application, the Examiner is courteously invited to contact the undersigned counsel.

Respectfully submitted,

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